

## REMARKS

### *Claim Status*

Claims 1-6, 8-15, and 17-31 are pending. Claims 1-6, 8-15, and 17-31 were rejected.

The examiner has suggested that the word "including" in claims 25 and 28-31 be changed to the word "comprising". The applicant has examined these claims for this word and cannot find it. The applicant requests clarification on this matter.

### *Claim Rejections - 35 U.S.C. § 102*

The examiner has rejected Claims 1-9 as being anticipated by Kaplan (US Patent No. 5,047,232). The examiner cites Kaplan as teaching non-aqueous waterproof oil-based compositions that are used as vehicles for sunscreen compositions, and a method of preparing the said compositions (in col. 1, lines 7-14). Kaplan teaches jojoba oil, lanolin oil, coconut oil, olive oil, liquid lanolin and cottonseed oil, which are suitable cosmetic emollients (in col. 3, lines 49-54). Kaplan teaches semi-solid cosmetic emollients that include hydrogenated lanolin, petrolatum, isopropyl lanolate, butyl myristate, cetyl myristate, cetyl alcohol and isocetyl lanolate (in col. 4, lines 12-20). The compositions may also contain dyes that can be defined as colorants, perfumes and antioxidants (in col. 5, lines 22-24). The examiner acknowledges that Kaplan is silent with respect to the teaching of the temperature range, the teaching of the particular range is inherent and encompassed therein. The examiner feels that Kaplan teaches a semi-solid emollient composition.

The applicant respectfully disagrees with the examiner. Kaplan does not anticipate the instant invention. While Kaplan does teach an emollient composition, the Kaplan emollient composition is clearly not semi-solid since it is intended as a vehicle for sunscreens. As such, the sunscreen vehicle would need to be liquid in order to be dispensed and dispersed on the dermis of the user. A semi-solid emollient composition,

in a sunscreen application, would likely irritate the dermis and provide incomplete coverage.

More importantly, the instant invention is an emollient composition that is used for cuticle treatment. See the independent claim 1. There is no teaching or suggestion in Kaplan that a transport vehicle for sunscreens, a protector of the dermal layers of the skin, would be useful for conditioning and protecting cuticles, which are solid protein layers.

In order for a reference to anticipate an invention that reference must contain a complete disclosure, in a single prior art source, of a device substantially identical to the claimed invention. Harris v. NRM Corp., 191 USPQ 643 (1976, ND Ohio). An invention is anticipated when **“all of the same elements are found in exactly the same situation and united in the same way to perform the function in a single prior art reference.”** Schroeder v. Owens Corning Fiberglas Corp., 514 F2d 90, 185 USPQ 723 (1975, CA9 Cal). (Citing Walker v. General Motors Corp. (CA9 Cal) 362 F2d 56, 58, 149 USPQ 472, 473, 474. An invention is not anticipated when the alleged anticipating device is substantially different in construction and operation from the claim invention. Fuller v. Yentzer, 94 US 299, 24 L. Ed. 107 (1877).

Clearly the Kaplan reference does not disclose a device that is substantially identical to the claimed invention. Kaplan discloses an emollient composition that is a transport vehicle for sunscreen compositions and the present invention discloses an emollient composition for treating cuticles. These are two clearly different inventions that have widely different functions. Further, there is no teaching or suggestion in Kaplan to make the Kaplan emollient composition semi-solid, as in the present invention. In fact, making the Kaplan emollient composition semi-solid, as required in claim 1, would render it unfit for use as a transport vehicle for sunscreens.

Therefore, the applicant respectfully requests that the examiner withdraw the instant rejection and allow claims 1-6 and 8-9.

***Claim Rejections - 35 U.S.C. § 103***

The examiner as rejected claims 1-9 as being obvious over Kaplan as applied above. The examiner acknowledges that Kaplan does not teach the particular temperature and feels that, absent a showing of criticality of the particular temperature, there are no unexpected results.

Kaplan has been distinguished above as being incorrectly applied above. Therefore, the claims are patentably distinct from the Kaplan invention. As for temperature, however, the applicant points out that the Kaplan invention is an emollient composition used as a transport vehicle for sunscreens. As such it is critical for the Kaplan composition to be a liquid in order to function. Thus the reason Kaplan is silent as to the particular temperature of the instant invention is because the Kaplan composition works for those temperatures where his composition is in a liquid state. The instant invention, however, since it is a semi-solid composition, has a distinct temperature range, which varies according to its composition, where too low a temperature would produce a solid that does not soften or melt around human body temperature and too high a temperature would produce a liquid; both unsuitable for the present invention. Therefore, the temperature ranges in the claims are those where the instant composition exists in a semi-solid state.

Thus, since Kaplan has been distinguished above, and since Kaplan's silence as to the claimed temperature range has no bearing on the reasons for the applicant's temperature range and does not support the examiners claim that the range is obvious, Kaplan and it's silence as to temperature do not render claims 1-6 and 8-9 obvious.

Therefore, the applicant respectfully requests that the examiner withdraw the instant rejection and allow claims 1-6 and 8-9.

The examiner has rejected claims 1-6, 8-15, and 17-31 as being obvious over Arquette (US Patent No. 5,968,530) in view of Miller (US Patent No. 4,286,609). The examiner feels that Arquette teaches an emollient composition that is used in cosmetic

products, and that the cosmetic products can be produced from fatty alcohols, isopropyl esters and wax esters, which can be obtained from jojoba oil. Arquette teaches jojoba wax esters (in col. 4, lines 40-62). Arquette teaches that the emollient compositions may be used as emollient carriers (in col. 7, lines 46-60). Arquette teaches fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks and sunscreens and insect repellants that may be combined with the emollient carrier (in col. 7, ins 46-60). Arquette discloses a process for making an emollient comprising the steps of a) providing a composition comprising jojoba oil, b) adding an alcohol to the said composition, c) effecting alcoholysis on said jojoba oil mixed with said alcohol to produce an emollient, and d) effecting interesterification of remaining wax esters (in col. 8, lines 49-67, bridging col. 9 lines 26).

The examiner acknowledges that Arquette does not specifically teach a container that retains the semi-solid emollient.

The examiner points to Miller as teaching a hot oil fingernail and cuticle treatment that is known in the art for moisturizing the tissues surrounding the nail (in col. 1, lines 21-35). Miller discloses using a bottle containing the inventive mixture that is used as a hot oil treatment. Miller also teaches that the treatment involves using a cuticle stick that is cylindrical in shape (in col. 2, lines 3-23). Miller teaches that the hot oil treatment uses a concentration of animal and vegetable oils, proteins, vitamins and other ingredients. The animal and vegetable oils include corn, olive, cottonseed, sesame and coconut oils (in col. 2, lines 24-37). Miller discloses a method for treating a cuticle using the emollients (in col. 4, liens 32-63).

The examiner feels that both references teach emollient compositions comprising oils and other ingredients. The examiner feels that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. The examiner feels that one having ordinary skill in the art would have been motivated to modify the composition of Arquette to include a container that retains the

emollient composition, because the third composition can be used for the same purpose of softening or moisturizing the cuticle and the tissues surrounding the nails.

The applicant respectfully disagrees with the examiner. While Arquette does teach an emollient composition, that the Arquette emollient composition may include, as an active ingredient, “fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks and sunscreens and insect repellants”, and a method for manufacture of the Arquette emollient composition, what Arquette does not teach or disclose is an emollient composition for cuticle treatment. A close examination of Arquette shows that Arquette contemplates use for his emollient composition as for softening the skin, the accepted definition of the word emollient. See the background and description of the preferred embodiment. There is no teaching or suggestion in Arquette to provide an emollient composition for treating cuticles, let alone a semi-soft composition.

Miller, on the other hand, discloses a hot oil composition for treating cuticles, which includes emollients. It is important to note that the Miller disclosure is for a **hot** treatment. When using the Arquette composition in the Miller invention, the heating of the composition (the emollient) liquefies the emollient. Thus, when combining Arquette with Miller the result is a hot liquid emollient composition of Arquette’s formula that treats cuticles. However, it is important to note that the instant invention is a semi-solid emollient composition for cuticle treatment, not a liquid emollient nor a hot liquid emollient. There is no teaching or suggestion in Miller to cool the treating oils, in deed, Miller requires heating by the inclusion of hot water with the oil mixture. Thus, the Miller disclosure can be seen to teach away from the examiner’s combination, thereby leading one of ordinary skill in the art away from the applicant’s invention, a semi-solid emollient composition for cuticle treatment.

For the reasons above, Arquette and Miller, either individually or in combination, cannot be fairly read to disclose the applicants invention. Therefore, the applicant respectfully requests that the examiner withdraw the instant rejection and allow claims 1-6, 8-15, and 17-31 to issue.

In re Application of: Brown  
Serial No.: 10/774,359  
Atty. Docket No.: 511-007

Art Group:  
Examiner: Howard, Sharon L.

Respectfully submitted,

Date: 10/18/04



Kristofer Halvorson, Reg. No. 39,211  
The Halvorson Law Firm, P.C.  
Attorneys for Applicant  
1757 E. Baseline Rd. Ste 130  
Gilbert, Arizona 85233  
(480) 892-2037

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage paid, in an envelope addressed to: Box Non Fee Amendment, Assistant Commission for Patents, PO Box 1450, Alexandria VA 22313-1450

on 10/18/04

By: 